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EXPRESS MAIL NO.: EV 452 773 505 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Palese et al.

Confirmation No.: 9897

Serial No.: 09/724,419

Art Unit: 1651

Filed: November 28, 2000

Examiner: Leon B. Lankford, Jr.

For: NOVEL METHODS AND INTERFERON  
DEFICIENT SUBSTRATES FOR THE  
PROPAGATION OF VIRUSES

Attorney Docket No: 6923-102

**COMMUNICATION REGARDING REFERENCES**

Mail Stop **ISSUE FEE**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The undersigned takes this opportunity to thank the Examiner for his helpful discussions on Monday, November 1, 2004 to ensure that all references which were considered by the Examiner and form part of the examination record are listed on the face of the patent that issues from the above-identified application.

The above-identified application is a divisional under 37 C.F.R. § 1.53(b) of parent application Serial No. 09/332,286 filed June 11, 1999; now U.S. Patent No. 6,573,079 ("079 patent). Both the parent patent and the present divisional application (which has been allowed) were examined by Examiner Lankford.

The references identified on the attached copy of the PTO-1449 form submitted in connection with the '079 patent (Attachment 1) were considered by the Examiner in the parent application (as indicated by the Examiner's notation), are printed on the face of the '079 patent (Attachment 2; references listed on Attachment 1 are indicated with a "+"), and form part of the examination record in the present application (MPEP § 609 I.A.2; information considered in parent application need not be re-submitted in continuing application).

On March 6, 2001, the Applicants submitted a compilation of the information disclosure statements filed in connection with the parent '079 patent

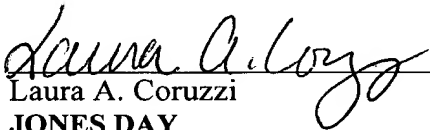
("compiled IDS") to ensure that this information will be printed on the patent that is scheduled to issue. However, the list in Attachment 1 was inadvertently omitted from the compiled IDS submitted to the Patent Office. In order to ensure that the patent, when granted, accurately reflects the examination record, the Examiner has kindly agreed to submit the list in Attachment 1 by way of a PTO-892 form so that the information will be correctly printed on the patent.

To assist the Examiner, we enclose a PTO-892 form (attached hereto as Attachment 3) listing the references which should be printed on the face of the patent in order to accurately reflect the prosecution record.

It is believed that no fee is due in connection with this Communication. If the U.S. Patent and Trademark Office determines otherwise, please charge the required fee to Jones Day Deposit Account 503013.

Respectfully submitted,

Date: November 5, 2004

  
Laura A. Coruzzi  
**JONES DAY**  
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30,742  
(Reg. No.)

**LIST OF REFERENCES CITED BY APPLICANT**

(Use several sheets if necessary)

ATTY. DOCKET NO.

6923-083

APPLICATION NO.

09/332,286

APPLICANT

Palese et al.

FILING DATE

June 11, 1999

GROUP

1651

**U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
W	DB	5,766,601	6/16/98	Palese et al.			
d	DC	5,882,650	3/16/99	Ennis			

**FOREIGN PATENT DOCUMENTS**

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
W	DD	WO 96/10632	4/11/96	PCT				

**OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)**

W	DE	Chang et al., 1992, "The E3L gene of vaccinia virus encodes an inhibitor of the interferon-induced, double-stranded RNA-dependent protein kinase", Proc. Natl. Acad. Sci USA 89:4825-4829
	DF	Cossins et al., 1993, "Precise Prediction of a K* Restricted Cytotoxic T Cell Epitope in the NS1 Protein of Influenza Virus Using an NHC Allele Specific Motif", Virology, 193:289-295
	DG	Hackett et al., 1992, "Influenza virus infection elicits class II major histocompatibility complex-restricted T cells specific for an epitope identified in the NS1 non structural protein", J. of Gen. Virology 73:1339-1343
	DH	Kattinger et al., 1997, "Attenuated Influenza Virus as a Vector for Mucosal Immunization Against HIV-1", Vaccine 315-319
	DI	Kuwano et al., 1990, "Cross reactive protection against influenza A virus infections by an NS1-specific CTL clone", Immunochimistry 113:499
	DJ	Kuwano et al., 1988, "HA2 Subunit of Influenza A H1 and H2 Subtype Viruses Induces a Protective Cross Reactive Cytotoxic T Lymphocyte Response", J. Immunol., 140:1264-1268
	DK	Maassab and DeBorde, 1983, "Characterization of an Influenza A Host Range Mutant", Virology 130:342-350
	DL	Shaw et al., 1982, "Immunologic Studies on the Influenza A Virus Nonstructural Protein NS", J. Exp. Med., 156:243-254
	DM	Snyder et al., 1990, "A 36 Nucleotide Deletion Mutation in the Coding Region of the SN1 Gene of an Influenza A Virus RNA Segment 8 Specifies a Temperature-Dependent Host Range Phenotype", Virus Research 15:69-84
	DN	Yoshida et al., 1981, "Characterization of the RNA Associated with Influenza A Cytoplasmic Inclusions and the Interaction of NS <sub>1</sub> Protein with RNA", Virology 110:87-97
	DO	Young et al., 1983, "Efficient Expression of Influenza Virus NS1", Proc. Natl. Acad. Sci. 80:605-6109

EXAMINER

L. Anderson

DATE CONSIDERED

2-8-2

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



**Notice of References Cited**

Application/Control No.	Applicant(s)/Patent Under Reexamination	
09/724,419	Palese et al.	
Examiner	Art Unit	Page 1 of 3
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**U.S. PATENT DOCUMENTS**

*		DOCUMENT NUMBER Country Code-Number-Kind Code	DATE MM-YYYY	NAME	CLASSIFICATION
	A	US-5,766,601	06-16-1998	Ennis	424/206.1
	B	US-5,882,650	03-16-1999	Ennis	424/206.1
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		DOCUMENT NUMBER Country Code-Number-Kind Code	DATE MM-YYYY	COUNTRY	NAME	CLASSIFICATION
	N	WO 96/10632	04-11-1996	PCT	Clarke et al.	C12N7/01
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		(Include as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Chang et al., 1992, "The E3L gene of vaccinia virus encodes an inhibitor of the interferon-induced, double-stranded RNA-dependent protein kinase", Proc. Natl. Acad. Sci USA 89:4825-4829
	V	Cossins et al., 1993, "Precise Prediction of a K <sup>k</sup> Restricted Cytotoxic T Cell Epitope in the NS1 Protein of Influenza Virus Using an NHC Allele Specific Motif", Virology, 193:289-295
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	X	Katinger et al., 1997, "Attenuated Influenza Virus as a Vector for Mucosal Immunization Against HIV-1", Vaccine 315-319

\*A copy of this reference is not being furnished with this Office Action (See MPEP § 707.05(a))  
Dates in MM-YYYY format are publication dates. Classification may be US or foreign.



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	M	US-				

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*		(Include as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Kuwano et al., 1990, "Cross reactive protection against influenza A virus infections by an NS1-specific CTL clone", Immunochemistry 113:499
	V	Kuwano et al., 1988, "HA2 Subunit of Influenza A H1 and H2 Subtype Viruses Induces a Protective Cross Reactive Cytotoxic T Lymphocyte Response", J. Immunol., 140:1264-1268
	W	Maassab and DeBorde, 1983, "Characterization of an Influenza A Host Range Mutant", Virology 130:342-350
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Application/Control No.

09/724,419

Applicant(s)/Patent Under  
Reexamination

Palese et al.

Examiner

Leon B. Lankford, Jr.

Art Unit

1651

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## FOREIGN PATENT DOCUMENTS

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	U	Snyder et al., 1990, "A 36 Nucleotide Deletion Mutation in the Coding Region of the SN1 Gene of an Influenza A Virus RNA Segment 8 Specifies a Temperature-Dependent Host Range Phenotype", Virus Research 15:69-84
	V	Yoshida et al., 1981, "Characterization of the RNA Associated with Influenza A Cytoplasmic Inclusions and the Interaction of NS <sub>1</sub> Protein with RNA", Virology 110:87-97
	W	Young et al., 1983, "Efficient Expression of Influenza Virus NS1", Proc. Natl. Acad. Sci. 80:6'05-6109
	X	

\*A copy of this reference is not being furnished with this Office Action (See MPEP § 707.05(a))  
Dates in MM-YYYY format are publication dates. Classification may be US or foreign.



JONES DAY

JP006612  
Our Ref. No. 6923-102-999  
CAM No. 702827-999101  
November 5, 2004

To: Josh Woods

Mount Sinai School of Medicine of New York University

Re: U.S. Application Serial No. 09/724,419  
Filed: November 28, 2000  
Entitled: NOVEL METHODS AND INTERFERON DEFICIENT  
SUBSTRATES FOR THE PROPAGATION OF VIRUSES  
By: Palese et al.

Please hand deliver a courtesy copy of the documents, listed below, in connection with the above-identified application to Examiner Leon B. Lankford, Jr. of Art Unit 1651 on **Monday, November 8, 2004**. Please telephone the Examiner in advance of the delivery (571-272-0917) and arrange a time with the Examiner that you can meet with him at Group Reception for delivery.

1. Communication Regarding References;
2. copy of a List of References Cited for Application Serial No. 09/322,286;
3. Face pages of U.S. Patent No. 6,573,079;
4. PTO-892 form.

Please let me know when you have made the delivery. Thank you.

Henry P. Wu  
(212) 326-7855  
7-7855

c: Laura Coruzzi, Esq.  
Jennifer Chheda, Esq.